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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Killick	)	
	)	
Serial No. 09/520,576	)	
	)	
Filed: March 8, 2000	)	Art Unit: 3622
	)	
For: Disaggregated Databases for	)	Examiner: Duran, Arthur D.
Tracking Consumer Purchasing	)	
Data	)	

**APPLICANT'S APPEAL BRIEF**

Dear Sirs:

Pursuant to 37 C.F.R. §1.192 and M.P.E.P. §1206, the Applicant submits this Appeal Brief, to the Board of Patent Appeals and Interferences. This brief is in response to the Office Action mailed on July 21, 2004 and the Notice of Appeal transmitted by Express Mail with a Certificate of Mailing date of November 18, 2004.

This Appeal Brief is timely within the time period set forth in §41.37, which provides that the appellant must file an appeal brief within two months from the date of filing of the notice of appeal, which is extendable under § 1.136(a) and (b) for up to five months after the two month time period. Submitted herewith is a check for a one month extension of time under §1.136 and 1.17(a), with the remainder of the fee for the second month extension payable by deposit account. Also submitted herewith is the Appeal Brief fee of \$500.00 pursuant to 37 C.F.R. §1.17(c).

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I hereby certify that this paper or fee is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on March 18, 2005.

William R. Silverio

## **I. REAL PARTY IN INTEREST**

This application is assigned to The Cocoa-Cola Company. An assignment from the inventor to The Cocoa-Cola Company was recorded with the Patent Office at reel 011543 and frame 0642 on February 21, 2001.

## **II. RELATED APPEALS AND INTERFERENCES**

The Applicant is not aware of any related appeals or interferences

## **III. STATUS OF CLAIMS**

All pending claims, Claims 34-40, 42, 43, 46, 47 and 50-60, stand rejected. All claims are appealed herein. The claims are attached hereto in Appendix A.

## **IV. STATUS OF AMENDMENTS**

An Amendment Under §41.33(b) is filed concurrently with this brief under separate paper. The Amendment cancels two claims. The listing of claims in Appendix A identifies the two canceled claims. No other amendments were filed after the rejection in the Final Office Action of July 21, 2004.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The independent claims involved in the appeal are Claims 34 and 51.

Claim 34: Claim 34 is directed to a system 100 for analyzing consumer data. An exemplary system 100 is illustrated in FIG. 1. More specifically, the claimed system 100 (Specification, Page 6, line 9 to Page 12, line 24) includes a terminal device 112 (Specification, Page 10, line 20 to Page 11, line 9) for accessing a consumer data acquisition device 110 (Specification, Page 8, line 23 to Page 9, line 14), where the terminal device 112 extracts data, such as purchasing data and personal preferences, from the data acquisition device 110 (Specification, Page 10, lines 21-27). The claimed system 100 also includes a collection center 114 (Specification, Page 11, line 11 to Page 12, line 7) having a computer program operating on a computer 126 (Specification, Page 11, line 15 to Page 12, line 7; Page 7, line 14 to Page 8, line 21). The computer program can analyze the purchasing data and preferences received from the terminal device 112 (Specification, Page 7, lines 14-18). Because the computer program and collection center 114 serve as a central repository for tracking purchasing data and preferences

from one or more terminals (Specification, Page 11, line 11 to Page 12, line 7; Page 13, lines 21-25), the collection center 114 is illustrated as separate from the terminal 112 in FIG. 1. The computer program at the collection center 114 provides instruction to the terminal device 112 on what data to extract from the data acquisition device 110 (Specification, Page 16, lines 3-28).

Claim 51: Claim 51 is also directed to a system 100 for analyzing consumer data. An exemplary system 100 is illustrated in FIG. 1. More specifically, the claimed system 100 (Specification, Page 6, line 9 to Page 12, line 24) includes a terminal device 112 (Specification, Page 10, line 20 to Page 11, line 9) for accessing a consumer data acquisition device 110 (Specification, Page 8, line 23 to Page 9, line 14), where the terminal device 112 extracts data, such as purchasing data and personal preferences, from the data acquisition device 110 (Specification, Page 10, lines 21-27). The claimed system 100 also includes a computer program for analyzing consumer data stored by the consumer data acquisition device 110. The computer program may be executed in part on the consumer data acquisition device (Specification, Page 16, lines 3-28) and in part at another location, such as on a computer 126 (Specification, Page 11, line 15 to Page 12, line 7; Page 7, line 14 to Page 8, line 21) at a collection center 114 (Specification, Page 11, line 11 to Page 12, line 7). The computer program can analyze the purchasing data and preferences received from the terminal device 112 (Specification, Page 7, lines 14-18). The claimed system 100 also includes a collection center 114 (Specification, Page 11, line 11 to Page 12, line 7) that provides instruction to the terminal device 112 on what data to extract from the data acquisition device 110 (Specification, Page 16, lines 3-28). The terminal device 112 extracts data, such as purchasing data and personal preferences, from the data acquisition device 110 (Specification, Page 10, lines 21-27) for further analysis by the computer program (Specification, Page 16, lines 3-28).

For reference purposes, Claims 34 and 49 are reproduced below with reference to the reference characters in FIG. 1 of the application:

34. A system [100] for analyzing consumer data, comprising:  
a terminal device [112];  
a consumer data acquisition device [110] that stores consumer data; and  
a computer program [e.g., computer program resident on computer 126] for analyzing consumer data wherein said computer program is at least in part remote from said terminal device, and

a collection center [114], in communication with the terminal device [112], where the collection center [114] instructs the terminal device [112] to extract all or part of the consumer data from the consumer data acquisition device [110],

wherein the terminal device [112] is operable to extract at least a portion of the consumer data stored on the consumer data acquisition device [110] for analysis by the computer program.

51. A system [100] for analyzing consumer data, comprising:

a terminal device [112];

a consumer data acquisition device [110] that stores consumer data; and

a computer program for analyzing consumer data wherein said computer program is executed at least in part at said consumer data acquisition device [110] and at least in part at another location [e.g., executed at the terminal device 112 and/or the computer 126 at the collection center 114]; and

a collection center [114], in communication with the terminal device [112], where the collection center [114] instructs the terminal device [112] to extract all or part of the consumer data from the consumer data acquisition device [110],

wherein the terminal device [112] is operable to extract at least a portion of the consumer data stored on the consumer data acquisition device [110] for further analysis by the computer program.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

A. Claims 34-40, 42, 43, 46, 47 and 50-60 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,327,570 to Stevens ("*Stevens*") in view of "What Grocers Want in Electronic Marketing Programs" ("*What Grocers Want*"), POS News, v.7, n.13, 5/91 and in view of U.S. Patent No. 6,321,208, to Barnett ("*Barnett*").

B. Claims 34-40, 42, 43, 46, 47 and 50-60 also stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,024,288 to Gottlich ("*Gottlich*") in view of *What Grocers Want* and in view of *Barnett*.

## VII. ARGUMENT

### A. The §103 Rejection of Independent Claims 34 and 51 over *Stevens* in view of *What Grocers Want* and in view of *Barnett* is Improper

The rejection of Claims 34-40, 42, 43, 46, 47 and 50-60 under 35 U.S.C. §103(a) as unpatentable over *Stevens* in view of *What Grocers Want* and in view of *Barnett*, was improper. The Examiner has not established a proper *prima facie* case of obviousness. The recited references do not provide each of the elements of the claims, either alone or in combination. The Examiner has also not met his burden to set forth particular findings “as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components in the manner claimed” *In re Lee*, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002).

#### 1. The Cited References

*Stevens* discloses a system including a personal data device that is worn by a consumer and which communicates with products and private store networks. The personal data device includes local processing means with an interactive display and wireless communications hardware. The system disclosed by *Stevens* may include a master or central node that is in communication with one or more databases (see col. 6, lines 61-67), where the master or central node can perform statistical analysis of consumer business data and product sales information to predict trends, target specific consumers, or provide feedback to participating businesses (see col. 8, lines 9-15). The system may also include a business network having in-store local communication units in communication with a customer’s personal data device when the customer is near or in a store. Additionally, the personal data device may communicate with the in-store units, which in turn serve information to the master node. Although *Stevens* discloses that a master control node can communicate with the data device, for instance via a business or store unit, *Stevens* does not disclose or suggest that a remote collection center dictate what information the terminal extracts from the data device. On the contrary, in *Stevens* the master control node simply receives data pushed to it from the personal data device, directly or via an in-store network. This distinction is supported by the Final Office Action of July 21, 2004, where the Examiner recites *What Grocers Want* for the selective extraction of consumer data for analysis (see Final Office Action, Page 3).

Next, *What Grocers Want* discloses that grocers want a simple program for implementing frequent shopper programs, where customers can receive incentives, e.g., cash back, at point of sale devices. Such a program may include a debit card or the like. Data associated with a

frequent shopper program may be used to gather marketing information at the point of sale.

*What Grocers Want* states:

By putting the frequent shopper feature on a proprietary debit card, stored get debit cards into more hands and customers are likely to use their cards for payment once they've already removed them from their wallets to get frequent shopper points. But retailers now not only know they want frequent shopper programs, but they are more certain than they were a few months ago about what they want in a program. What they want is a simple program that rewards customer loyalty and at the same time allows them to gather data that is useful in target marketing. They also want control over what customer data is collected and where that information goes.

See *What Grocers Want*, Paragraphs 4 and 5.

The Examiner relies on *What Grocers Want* for the selective extraction of information from a consumer device, and for the proposition that retailers would like to control what information is collected from a consumer, and how that information is used to provide incentives (see Office Action mailed July 21, 2004, Page 3, 1<sup>st</sup> full paragraph). *What Grocers Want* describes that it is an advantage to track, using point of sale systems, local purchases made by consumers. This local control of data at the sale location permits individual retailers to customize frequent shopper programs as they deem appropriate. However, *What Grocers Wants* does not disclose or suggest an external collection center that is in active communication with a terminal device such as a Point of Sale (POS) terminal, where the collection center instructs the terminal to extract all or part of the consumer data from the consumer data acquisition device.

The third reference used in the §103 rejection is *Barnett*. *Barnett* discloses a system for the electronic distribution of product coupons to a user via a personal computer located at the user's home. More specifically, a user may download coupons from an online service provider, such as a web site on the Internet. The user may print out the coupons and present them at a retail store, after which a discount is provided to the user. Upon redemption by the store, transaction data is also supplied to the coupon issuers and distributor for integration into a marketing analysis. The marketing analysis may also receive redemption data supplied by the online service provider. For instance, the marketing information may include what coupons are downloaded from the internet site (based on download information provided by the online service provider), and what coupons are redeemed (based on coupon redemption requests received by stores after a user has used a printed coupon). The Examiner cites col. 5, lines 27-35, and col. 12, lines 30-36 as disclosing the use of a collection center to instruct a terminal

device to extract information from a consumer data acquisition device. However, that language merely describes that a central repository may receive information from the online service provider as to the coupons downloaded by users, and that individual stores may also provide redemption information to the central repository. Thus, there is no active solicitation or extraction in *Barnett* of data on a consumer device.

## **2. The Independent Claims are Distinguishable from the Cited**

### **References**

The independent claims recite systems that are clearly distinguishable from those provided by *Stevens*, *What Grocers Want*, and *Barnett*. Independent Claim 34 recites a computer program for analyzing consumer data, where the computer program is at least in part remote from said terminal device, and a collection center, in communication with the terminal device, where the collection center instructs the terminal device to extract all or part of the consumer data from the consumer data acquisition device. Independent Claim 51 has similar language, including a computer program at least in part at and remote from the consumer data acquisition device, and a collection center, in communication with the terminal device, where the collection center instructs the terminal device to extract all or part of the consumer data from the consumer data acquisition device.

One significant benefit of the present invention is to permit the consumer acquisition device to include an analysis program and/or to allow the collection center to build an inferred marketing database while the data of the system is distributed throughout the system. The claims recite that the computer program performing the analysis is remote from, rather than executed at, the terminal. Further, the amended claims recite that the collection center instructs the terminal device to extract all or part of the consumer data from the consumer data acquisition device. This permits selective extraction of data as dictated by a remote device. None of the recited references disclose, teach, or suggest that a collection center can dictate what information is selectively extracted from a consumer device.

First, with respect to *Stevens*, *Stevens* discloses that a master control node can communicate with the data device, for instance via a business or store unit. However, *Stevens* does not disclose or suggest that a remote collection center can instruct a terminal device as to the information the terminal should extract from the data device. On the contrary, in *Stevens* the master control node simply receives data pushed to it from the personal data device, directly or via an in-store network. This distinction is supported by the Final Office Action of July 21,

2004, where the Examiner recites *What Grocers Want* for the selective extraction of consumer data for analysis (see Final Office Action, Page 3). Unlike the system of *Stevens*, the two independent claims, Claims 34 and 51, recite that the collection center instructs the terminal device to extract all or part of the consumer data from the consumer data acquisition device, which permits the collection center to build and maintain an inferred marketing database. It will be appreciated by those of ordinary skill in the art that a system whereby all information is pushed from one device to another is significantly different, and more simple, than a system whereby multiple components may communicate what data is required by the system based on rules executed by a remote entity.

It is clear that the systems described in *What Grocers Want* fail to disclose or teach the claimed invention for the same reasons. Although *What Grocers Want* does not include any particulars on how a frequent shopper program may be actually constructed, it appears that *What Grocers Want* is limited to systems having local control of data. This local control of data at the sale location permits individual retailers to customize frequent shopper programs as they deem appropriate. And significantly, like *Stevens*, *What Grocers Want* does not suggest that POS devices are intelligent in that they extract select information from a debit card based on a command received external from the POS device. In fact, not only is the selective extraction of information by a remote device not suggested, there is no disclosure or discussion of a central repository of information in *What Grocers Want*. Additionally, even though *What Grocers Want* states that some grocers may track information about some, but not all items, purchased, there is no disclosure that only portions of information are pulled from devices. Thus, *What Grocers Want* does not teach or disclose a collection center in communication with a terminal device, where the collection center instructs the terminal device to extract either all or only a selective part of consumer data from a consumer data acquisition device, as required by the independent claims.

Next, with respect to *Barnett*, the Examiner cites col. 5, lines 27-35, and col. 12, lines 30-36 as disclosing the use of a collection center to instruct a terminal device to extract information from a consumer data acquisition device. However, that language merely describes that a central repository may receive information from the online service provider as to the coupons downloaded by users, and that individual stores may also provide redemption information to the central repository. In fact, in *Barnett* there is no discussion of a consumer data acquisition device from which information may be extracted. In marked contrast to the claimed present



invention, all of the information received by the central repository in *Barnett* is from the online service provider or store. There is no consumer device, nor is there the extraction of consumer data from the device. Additionally, to the extent the Examiner may interpret the consumer device to be the user's computer, there is no data extracted from the user's computer, nor is there any extraction of information on the computer by a terminal device. Therefore, like *Stevens* and *What Grocers Want*, there is not disclosure or teaching by *Barnett* of a collection center in communication with a terminal device, where the collection center instructs the terminal device to extract either all or only a selective part of consumer data from a consumer data acquisition device, as required by the independent claims.

### 3. There is No Proper Motivation to Combine the Cited References

The CAFC has stated that "the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for showing of the teaching or motivation to combine prior art references." *In re Dembiczak*, 175 F.3d 994 at 999 (Fed. Cir. 1999). While the suggestion to combine may be found in explicit or implicit teachings within the references, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved, the "question is whether there is something in the prior art *as a whole* to suggest the desirability, and thus the obviousness, of making the combination. *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339 at 1355 (Fed. Cir. 1999). "The range of sources available, however, does not diminish the requirement for **actual evidence**. That is, the showing must be **clear and particular**." *In re Dembiczak*, 175 F.3d 994 at 999 (Fed. Cir. 1999) (emphasis added). Furthermore, that in hindsight of applicants' disclosure a skilled artisan arguably may be able to recognize, cull, modify, and combine certain claim elements from disparate references is not evidence of a clear and particular motivation to combine those references. *See, e.g., In re Lee*, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002).

In the present case, there is no clear and particular teaching to combine the references. The cited references relate to retail systems in which information may be gathered about the types of products or coupons purchased by consumers. However, that alone is insufficient evidence for a motivation to combine the references. The Examiner must provide a clear and particular showing as to why their combination would have been suggested. Notwithstanding that requirement, the motivation to combine the references is merely conclusory.

In the Final Office Action of July 21, 2004, the Examiner relies on *What Grocers Want* to disclose the selective extraction of consumer data for analysis and "inferring information from

the database”. It is not clear what the latter language means, and where it is supported in *What Grocers Want*, but the Examiner relies on that statement as the reason for combining *What Grocers Want* with *Stevens*, finding that it would have been obvious to limit the information gathered by the device in *Stevens* to avoid gathering too much information. The Examiner also asserts that this would limit the memory required on the card. Those statements are conclusory and do not provide any actual evidence for the combination of *Stevens* and *What Grocers Want*. Additionally, the Examiner relies on *What Grocers Want* for the proposition that too much consumer data information is extracted in frequent shopper systems. In fact, *What Grocers Want* cites this as a reason for more local control of data, as opposed to a more distributed control, such as in the claimed system (See *What Grocers Want*, Page 1, Paragraph 6). Therefore, not only is the motivation for combining the references insufficient, but the references themselves teach against their combination.

Likewise, the Examiner fails to provide sufficient motivation for the further combination of *Barnett* with *Stevens* and *What Grocers Want*. As noted above, *Barnett* does not disclose the extraction of data from a consumer device by a collection center, as the central repository in *Barnett* passively receives information from an online service provider and stores in which coupons are redeemed. Nevertheless, the Examiner states that it would have been obvious to combine *Barnett* with *Stevens* and *What Grocers Want* to “add *Barnett*’s variably distributed information providing and analysis features to *Stevens*’ analysis of consumer data”, for the reason of providing flexible and expansive options for consumer analysis.” (See Final Office Action, Page 4). No additional statements of motivation are provided. Applicant respectfully asserts that this statement is insufficient, as it is conclusory and is not supported by any actual evidence in *Stevens* or *Barnett*. In fact, the only similarity between the two references is that both *Stevens* and *Barnett* include passive central repositories that only receive information transmitted to the repositories, with neither acting to selectively extract information from a consumer device, as is facilitated by the present invention.

For each of the reasons above, Applicant respectfully asserts that Independent Claims 34 and 51 be allowed, along with the claims depending there from.

**B. The §103 Rejection of Independent Claims 34 and 51 over *Gottlich* in view of *What Grocers Want* and in view of *Barnett***

The rejection of Claims 34-40, 42, 43, 46, 47 and 50-60 under 35 U.S.C. §103(a) as unpatentable over *Gottlich* in view of *What Grocers Want* and in view of *Barnett*, was improper. The Examiner has not established a proper *prima facie* case of obviousness. The recited references do not provide each of the elements of the claims, either alone or in combination. The Examiner has also not met his burden to set forth particular findings “as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components in the manner claimed” *In re Lee*, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002).

**1. The Cited References**

*Gottlich* discloses a smart card device held by a consumer, where the smart card maintains historical transaction information. The card may be inserted into a kiosk or terminal that will read the information on the card and offer incentives and coupons. *Gottlich* also indicates that the card may include communication means to communicate with an outside source to transfer and/or receive data such as a user’s personal or purchasing history, promotional offers, or updates to software (col. 8, lines 46-57). However, *Gottlich* fails to disclose or suggest a collection center, in communication with the terminal device, where the collection center instructs the terminal device to extract all or part of the consumer data from the consumer data acquisition device, as recited by independent Claims 34 and 51. Like *Stevens*, the information retrieved from the card in *Gottlich* is simply transmitted to an outside source. The outside source does not instruct the kiosk what content to extract from the card. This distinction is supported by the Final Office Action of July 21, 2004, where the Examiner recites *What Grocers Want* for the selective extraction of consumer data for analysis (see Final Office Action, Page 3).

*What Grocers Want* discloses that grocers want a simple program for implementing frequent shopper programs, where customers can receive incentives, e.g., cash back, at point of sale devices. Such a program may include a debit card or the like. Data associated with a frequent shopper program may be used to gather marketing information at the point of sale. *What Grocers Want* states:

By putting the frequent shopper feature on a proprietary debit card, stored get debit cards into more hands and customers are likely to use their cards for payment once they’ve already removed them from their wallets to get frequent shopper points. But retailers now not only know they want frequent shopper

programs, but they are more certain than they were a few months ago about what they want in a program. What they want is a simple program that rewards customer loyalty and at the same time allows them to gather data that is useful in target marketing. They also want control over what customer data is collected and where that information goes.

See *What Grocers Want*, Paragraphs 4 and 5.

The Examiner relies on *What Grocers Want* for the selective extraction of information from a consumer device, and for the proposition that retailers would like to control what information is collected from a consumer, and how that information is used to provide incentives (see Office Action mailed July 21, 2004, Page 3, 1<sup>st</sup> full paragraph). *What Grocers Want* describes that it is an advantage to track, using point of sale systems, local purchases made by consumers. This local control of data at the sale location permits individual retailers to customize frequent shopper programs as they deem appropriate. However, *What Grocers Wants* does not disclose or suggest an external collection center that is in active communication with a terminal device such as a Point of Sale (POS) terminal, where the collection center instructs the terminal to extract all or part of the consumer data from the consumer data acquisition device.

The third reference used in the §103 rejection is *Barnett*. *Barnett* discloses a system for the electronic distribution of product coupons to a user via a personal computer located at the user's home. More specifically, a user may download coupons from an online service provider, such as a web site on the Internet. The user may print out the coupons and present them at a retail store, after which a discount is provided to the user. Upon redemption by the store, transaction data is also supplied to the coupon issuers and distributor for integration into a marketing analysis. The marketing analysis may also receive redemption data supplied by the online service provider. For instance, the marketing information may include what coupons are downloaded from the internet site (based on download information provided by the online service provider), and what coupons are redeemed (based on coupon redemption requests received by stores after a user has used a printed coupon). The Examiner cites col. 5, lines 27-35, and col. 12, lines 30-36 as disclosing the use of a collection center to instruct a terminal device to extract information from a consumer data acquisition device. However, that language merely describes that a central repository may receive information from the online service provider as to the coupons downloaded by users, and that individual stores may also provide redemption information to the central repository. Thus, there is no active solicitation or extraction in *Barnett* of data on a consumer device.

## **2. The Independent Claims are Distinguishable from the Cited References**

The independent claims recite systems that are clearly distinguishable from those provided by *Gottlich*, *What Grocers Want*, and *Barnett*. Independent Claim 34 recites a computer program for analyzing consumer data, where the computer program is at least in part remote from said terminal device, and a collection center, in communication with the terminal device, where the collection center instructs the terminal device to extract all or part of the consumer data from the consumer data acquisition device. Independent Claim 51 has similar language, including a computer program at least in part at and remote from the consumer data acquisition device, and a collection center, in communication with the terminal device, where the collection center instructs the terminal device to extract all or part of the consumer data from the consumer data acquisition device.

One significant benefit of the present invention is to permit the consumer acquisition device to include an analysis program and/or to allow the collection center to build an inferred marketing database while the data of the system is distributed throughout the system. The claims recite that the computer program performing the analysis is remote from, rather than executed at, the terminal. Further, the amended claims recite that the collection center instructs the terminal device to extract all or part of the consumer data from the consumer data acquisition device. This permits selective extraction of data as dictated by a remote device. None of the recited references disclose, teach, or suggest that a collection center can dictate what information is selectively extracted from a consumer device.

First, *Gottlich* fails to provide any disclosures or teachings that overcome the deficiencies of the §103 rejections based on *Stevens*. Therefore, the discussion and arguments above with respect to the §103 rejection under *Stevens* in view of *What Grocers Want* and *Barnett* are also applicable here. *Gottlich* fails to disclose or suggest a collection center, in communication with the terminal device, where the collection center instructs the terminal device to extract all or part of the consumer data from the consumer data acquisition device, as recited by independent Claims 34 and 51. Like *Stevens*, the information retrieved from the card in *Gottlich* is simply transmitted to an outside source. The outside source does not instruct the kiosk what content to extract from the card. This distinction is supported by the Final Office Action of July 21, 2004, where the Examiner recites *What Grocers Want* for the selective extraction of consumer data for analysis (see Final Office Action, Page 3).

It is clear that the systems described in *What Grocers Want* fail to disclose or teach the claimed invention for the same reasons. Although *What Grocers Want* does not include any particulars on how a frequent shopper program may be actually constructed, it appears that *What Grocers Want* is limited to systems having local control of data. This local control of data at the sale location permits individual retailers to customize frequent shopper programs as they deem appropriate. And significantly, like *Gottlich*, *What Grocers Want* does not suggest that POS devices are intelligent in that they extract select information from a debit card based on a command received external from the POS device. In fact, not only is the selective extraction of information by a remote device not suggested, there is no disclosure or discussion of a central repository of information in *What Grocers Want*. Additionally, even though *What Grocers Want* states that some grocers may track information about some, but not all items, purchased, there is no disclosure that only portions of information are pulled from devices. Thus, *What Grocers Want* does not teach or disclose a collection center in communication with a terminal device, where the collection center instructs the terminal device to extract either all or only a selective part of consumer data from a consumer data acquisition device, as required by the independent claims.

Next, with respect to *Barnett*, the Examiner cites col. 5, lines 27-35, and col. 12, lines 30-36 as disclosing the use of a collection center to instruct a terminal device to extract information from a consumer data acquisition device. However, that language merely describes that a central repository may receive information from the online service provider as to the coupons downloaded by users, and that individual stores may also provide redemption information to the central repository. In fact, in *Barnett* there is no discussion of a consumer data acquisition device from which information may be extracted. In marked contrast to the claimed present invention, all of the information received by the central repository in *Barnett* is from the online service provider or store. There is no consumer device, nor is there the extraction of consumer data from the device. Additionally, to the extent the Examiner may interpret the consumer device to be the user's computer, there is no data extracted from the user's computer, nor is there any extraction of information on the computer by a terminal device. Therefore, like *Gottlich* and *What Grocers Want*, there is not disclosure or teaching by *Barnett* of a collection center in communication with a terminal device, where the collection center instructs the terminal device to extract either all or only a selective part of consumer data from a consumer data acquisition device, as required by the independent claims.

### 3. There is No Proper Motivation to Combine the Cited References

The CAFC has stated that “the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for showing of the teaching or motivation to combine prior art references.” In re Dembiczak, 175 F.3d 994 at 999 (Fed. Cir. 1999). While the suggestion to combine may be found in explicit or implicit teachings within the references, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved, the “question is whether there is something in the prior art *as a whole* to suggest the desirability, and thus the obviousness, of making the combination. WMS Gaming, Inc. v. International Game Technology, 184 F.3d 1339 at 1355 (Fed. Cir. 1999). “The range of sources available, however, does not diminish the requirement for **actual evidence**. That is, the showing must be **clear and particular**.” In re Dembiczak, 175 F.3d 994 at 999 (Fed. Cir. 1999) (emphasis added). Furthermore, that in hindsight of applicants’ disclosure a skilled artisan arguably may be able to recognize, cull, modify, and combine certain claim elements from disparate references is not evidence of a clear and particular motivation to combine those references. *See, e.g., In re Lee*, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002).

In the present case, there is no clear and particular teaching to combine the references. The cited references relate to retail systems in which information may be gathered about the types of products or coupons purchased by consumers. However, that alone is insufficient evidence for a motivation to combine the references. The Examiner must provide a clear and particular showing as to why their combination would have been suggested. Notwithstanding that requirement, the motivation to combine the references is merely conclusory.

In the Final Office Action of July 21, 2004, the Examiner relies on *What Grocers Want* to disclose the selective extraction of consumer data for analysis and “inferring information from the database”. It is not clear what the latter language means, and where it is supported in *What Grocers Want*, but the Examiner relies on that statement as the reason for combining *What Grocers Want* with *Gottlich*, finding that it would have been obvious to limit the information gathered by the device in *Gottlich* to avoid gathering too much information. The Examiner also asserts that this would limit the memory required on the card. Those statements, which are, quite tellingly, identical to the reasons for combining *What Grocers Want* with *Stevens*, are conclusory and do not provide any actual evidence for the combination of *Gottlich* and *What Grocers Want*. Additionally, the Examiner relies on *What Grocers Want* for the proposition that too much consumer data information is extracted in frequent shopper systems. In fact, *What Grocers Want*

cites this as a reason for more local control of data, as opposed to a more distributed control, such as in the claimed system (See *What Grocers Want*, Page 1, Paragraph 6). Therefore, not only is the motivation for combining the references insufficient, but the references themselves teach against their combination.

Likewise, the Examiner fails to provide sufficient motivation for the further combination of *Barnett* with *Gottlich* and *What Grocers Want*. As noted above, *Barnett* does not disclose the extraction of data from a consumer device by a collection center, as the central repository in *Barnett* passively receives information from an online service provider and stores in which coupons are redeemed. Nevertheless, the Examiner states that it would have been obvious to combine *Barnett* with *Gottlich* and *What Grocers Want* to “add *Barnett*’s variably distributed information providing and analysis features to *Gottlich*’s analysis of consumer data”, for the reason of providing flexible and expansive options for consumer analysis.” (See Final Office Action, Page 4). Those statements are identical to the reasons set forth by the Examiner for combining *Barnett* with *Gottlich*. No additional statements of motivation are provided.

Applicant respectfully asserts that this statement is insufficient, as it is conclusory and is not supported by any actual evidence in *Gottlich* or *Barnett*. In fact, the only similarity between the two references is that both *Gottlich* and *Barnett* include passive central repositories that only receive information transmitted to the repositories, with neither acting to selectively extract information from a consumer device, as is facilitated by the present invention.

For each of the reasons above, Applicant respectfully asserts that Independent Claims 34 and 51 be allowed, along with the claims depending there from.

**C. The §103 Rejection of Dependent Claims 35-40, 42, 43, 46, 47, 50, and 52-60 over *Stevens* or *Gottlich* in view of *What Grocers Want* and in view of *Barnett***

Applicant respectfully asserts that the rejections of the dependent claims, Claims 35-40, 42, 43, 46, 47, 50, and 52-60, are insufficient. The Examiner provides no recitation as to why any of the recited references reads on the elements of each of the claims. Additionally, each of the dependent claims are allowable as being based on an allowable independent claim.

**VIII. CLAIMS APPENDIX**

The following is a copy of the claims involved in this appeal:



34. A system for analyzing consumer data, comprising:  
a terminal device;  
a consumer data acquisition device that stores consumer data; and  
a computer program for analyzing consumer data wherein said computer program is at least in part remote from said terminal device, and  
a collection center, in communication with the terminal device, where the collection center instructs the terminal device to extract all or part of the consumer data from the consumer data acquisition device,  
wherein the terminal device is operable to extract at least a portion of the consumer data stored on the consumer data acquisition device for analysis by the computer program.

35. The system of claim 34, wherein the terminal device is further operable to transmit consumer data to said consumer data acquisition device.

36. The system of claim 34, wherein said consumer data acquisition device is selected from the group of devices consisting of a Radio Frequency Identification (RFID) tag, a magnetic medium, an RFID tag having memory, a magnetic medium having memory, a bar code reader having memory, a digital computer, a personal digital assistant, a pager, and a cellular telephone.

37. The system of claim 34, wherein said terminal device is positioned local to at least one device selected from the group of devices consisting of an ATM machine, a vending machine, a point-of-sale terminal, and a network terminal.

38. The system of claim 35, wherein said terminal device is operable to clear at least a portion of said consumer data from a memory of said consumer data acquisition device in which the consumer data is stored.

39. The system of claim 35, wherein said terminal device is operable to modify at least a portion of said consumer data from a memory of said consumer data acquisition device in which the consumer data is stored.

40. The system of claim 34, wherein said computer program is operable to analyze consumer data, said analysis further comprising filtering said consumer data.

41. (canceled)

42. The system of claim 34, wherein the terminal device is operable to extract at least a portion of unfiltered consumer data stored on the consumer data acquisition device for analysis by the computer program.

43. The system of claim 34, wherein the terminal device is operable to extract only a portion of the consumer data stored on the consumer data acquisition device for analysis by the computer program.

44. (canceled)

45. (canceled)

46. The system of claim 34, further comprising a data collection center in communication with said terminal device, and wherein said computer program resides, at least in part, at said data collection center.

47. The system of claim 34, wherein the output of said analysis is an inferred marketing database.

48. (canceled)

49. (canceled)

50. The system of claim 34, wherein said at least a portion of the consumer data is extracted from the consumer data acquisition device based at least in part on instructions from the computer program.

51. A system for analyzing consumer data, comprising:  
a terminal device;  
a consumer data acquisition device that stores consumer data; and  
a computer program for analyzing consumer data wherein said computer program is executed at least in part at said consumer data acquisition device and at least in part at another location; and  
a collection center, in communication with the terminal device, where the collection center instructs the terminal device to extract all or part of the consumer data from the consumer data acquisition device,  
wherein the terminal device is operable to extract at least a portion of the consumer data stored on the consumer data acquisition device for further analysis by the computer program.

52. The system of claim 51, wherein the terminal device is further operable to transmit consumer data to said consumer data acquisition device.

53. The system of claim 51, wherein said at least a portion of the consumer data is extracted from the consumer data acquisition device based at least in part on instructions from the computer program.

54. The system of claim 51, wherein said consumer data acquisition device is selected from the group of devices consisting of a Radio Frequency Identification (RFID) tag, a magnetic medium, an RFID tag having memory, a magnetic medium having memory, a bar code reader having memory, a digital computer, a personal digital assistant, a pager, and a cellular telephone.

53. (second occurrence) (canceled by After Final Amendment filed Concurrently herewith)

54. (second occurrence) (canceled by After Final Amendment filed Concurrently herewith)

55. The system of claim 53, wherein said terminal device is operable to modify at least a portion of said consumer data from a memory of said consumer data acquisition device in which the consumer data is stored.

56. The system of claim 51, wherein said computer program is operable to analyze consumer data, said analysis further comprising filtering said consumer data.

57. The system of claim 51, wherein the terminal device is operable to extract at least a portion of unfiltered consumer data stored on the consumer data acquisition device for analysis by the computer program.

58. The system of claim 51, wherein the terminal device is operable to extract only a portion of the consumer data stored on the consumer data acquisition device for analysis by the computer program.

59. The system of claim 51, further comprising a data collection center in communication with said terminal device, and wherein said computer program resides, at least in part, at said data collection center.

60. The system of claim 51, wherein the output of said analysis is an inferred marketing database.

## **IX. EVIDENCE APPENDIX**

None. The references recited and discussed in the present brief are only those references entered by the Examiner, and recited by the Examiner, in previous Office Actions.

## **X. RELATED PROCEEDINGS APPENDIX**

There are no related proceedings.

## **XI. CONCLUSION**

The Applicant respectfully requests that the Board overturn the rejection of the claims.  
Any questions may be directed to the undersigned at 404.853.8214.

Respectfully submitted this 18<sup>th</sup> day of March 2005.

A handwritten signature in black ink, appearing to read "William R. Silverio", is written over a horizontal line.

William R. Silverio

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